UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,020	08/22/2003	Thomas Soares	CEN-002.1D	9249

26717 7590 03/12/2007

RONALD CRAIG FISH, A LAW CORPORATION
PO BOX 820
LOS GATOS, CA 95032

EXAMINER	
CORRALES, JONATHAN E	
ART UNIT	PAPER NUMBER
2169	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/646,020	SOARES ET AL.	
	Examiner	Art Unit	
	Jonathan E. Corrales	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 August 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the application filed on October 22, 2003.

Specification

2. The disclosure is objected to because of the following informalities:

- Page 1, paragraph 3, line 1, the acronyms ERP and CRM are not initially written in full;
- Page 1, paragraph 5, line 3, the acronyms DASD and NAS are not initially written in full;
- Page 2, paragraph 1, line 1, the acronym WAN is not initially written in full;
- Applicant is respectfully reminded of the arrangement of an application. (see MPEP 608.01(a)). Applicant has placed the summary of the invention after the brief description of the drawings. The summary of the invention should be placed before the brief description of the drawings;
- On page 10, 11 lines from the top, the applicant uses the trademark "LEGO." It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks;
- On page 10, paragraph 1, line 3, the applicant uses the trademark "DELL" which should be capitalized (see the objection above for more details).

Although the some minor informalities were listed above, the list is not intended to be an exhaustive list of all informalities found within the disclosure of the instant application. The examiner respectfully reminds applicant to be mindful of any additional informalities that the examiner may have missed and correct them in the communication following this office action. With regard to acronyms not initially written in full, although the examiner has listed some occurrences of acronyms not initially written in full, the applicant must also be mindful of additional acronyms with the same deficiency. The list of acronyms not initially written in full is in no way exhaustive. The initial recitation of what the acronyms stand for is helpful for one of ordinary skill in the art to understand what certain concepts are. Acronyms can change or evolve over time to represent something different than what they were initially intended to represent, and for the sake of clarification the examiner respectfully requests that all acronyms, not initially written in full, be written in full in the communication following this office action.

Appropriate correction is required.

Drawings

3. The drawings are objected to because of the following informalities:

- With regard to figure 1, the label for figure 1 is not clearly visible. Fig. 1 on the bottom of the page for figure 1 is not legible. The reference numbers for fig. 1 are also not clearly visible. Moreover, items 10, 12, and 14 are too dark for the labels inside of them to be visible;
- With regard to fig. 3A, there is a box with 4 references inside the box on the top left hand corner. This box is not a part of the flow chart. The

examiner respectfully requests the applicant removes this box from the figure;

- Items referenced by numbers 108 and 199 in figure 6 are too dark. The labels inside of these items are not clearly visible;
- With regard to Fig. 7B, the item labeled "end" does not have a reference number; and
- With regard to Fig. 6, item labeled "RFS's & SR's" does not have an accompanying number.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 1-4, 6, 7, and 9-10 are objected to because of the following informalities:

- In claim 1, line 4, the words "a user" should be –the user--. In line 6, the words "a user" should be –the user--. In line 9, the words "said computer input devices" should be –a plurality of computer input devices--. In line 11, the word "all" should be –said one or more--. In lines 14-15, the words "a data structure" should be –said data structure--;
- In claim 2, line 2, the words "a user" should be –the user--;
- In claim 3, line 1, the words "validation process" should be –step of validating each answer provided by the user--;
- In claim 4, line 1, the words "validation process" should be –step of validating each answer provided by the user--. In lines 4-5, the words "an IT professional" should be –said IT professional--;
- In claim 6, line 5, the words "an IT professional" should be –said IT professional--;
- In claim 7, line 5, the words "a user" should be –the user--. In line 9, the words "launching a service" should be –launch the service--. In line 16, the words "answer(s) to vector processing to" should be –user response(s) for vector processing--. In line 22, the word "all" should be –said one or more—;

- In claim 9, line 1, the words "validation processes" should be –validation of said responses--. In line 3, the words "a data structure" should be –the data structure--; and
- In claim 10, line 1, the words "validation processes" should be –validation of said responses--.

Although the some minor informalities were listed above, the list intended to be an exhaustive list of all informalities found within the disclosure of the instant application. The examiner respectfully reminds applicant to be mindful of any additional informalities that the examiner may have missed and correct them in the communication following this office action. The objections provided above are provide to point out those informalities that can potentially lead to indefiniteness and lack of proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, 12, and 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claims 1, 12, and 14, the claims are rejected as falling under the judicial exception of an abstract idea which lacks a useful, concrete, and tangible result. A claimed series of steps or acts that do not result in a useful, concrete, and tangible result are not statutory within the meaning of 35 USC 101. In the instant case, the

claims recite, "gathering recommended service actions and filling in fields in a data structure based upon answers given by said user [if assistance was requested]" and "if the user does not request assistance, soliciting information from a user to fill in all unpopulated data fields of a data structure defining one or more service actions [...]," and "validating user input." However, no useful, concrete, and tangible result is claimed. That is, it must produce a "useful, concrete and tangible result (emphasis added)." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). For example, "writing said data," "updating said data," "sending said data" being claimed at the end of the claim may comprise a useful, concrete, and tangible result. Absent such a result, however, the claims are not statutory.

Claims 2-6 depend on claim 1, and as a result of their dependency they inherit the deficiency of the claim it/they depend(s) on. Since the dependent claim(s) do not address the deficiencies stated above, they are rejected for at least the same reasons.

Claim 15 depends on claim 14, and as a result of its dependency it inherits the deficiency of the claim it/they depend(s) on. Since the dependent claim(s) does not address the deficiencies stated above, it is rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 2003/0036925 A1) in view of Chiang et al. (US 6381711 B1).

With regard to claim 1, Miller teaches displaying an IT services catalog (fig. 6, item 602 and section [0085]); determining if a user that wishes to order an IT service selects an option for computer assistance in selecting a service action(i.e., the user selecting an existing order template or not selecting an existing order template amounts to an option for computer assistance in selective a service action, [0087] and section [0088]; see also fig. 8; see also section [0036], lines 1-4); Miller teaches filling in fields in a data structure based upon answers given by said user (wherein the questions of Miller solicit information for filling out the templates, section [0098], lines 32-35 and fig. 5, item

505). Miller teaches if said user does not request assistance, soliciting said user to fill in all unpopulated fields of a data structure (soliciting the user to fill in unpopulated fields as shown in fig. 4) defining one or more service actions which are either selected by said user or which have been recommended by processing said decision tree and validating all user data input (Miller teaches selecting and/or creating new services in fig. 6, item 603; Miller teaches validating the user input in fig. 5, item 507; see also section [0053], lines 2-14 for the different types of constraints and/or validation formulas on parameters). Miller does not explicitly disclose if a user requests assistance, displaying questions in an order dictated by a decision tree defined in advance by an IT professional and traversing said decision tree based upon answers provided by the user via said computer input devices until one or more recommendations for service actions have been encountered nor gathering all recommended service actions. However, Chiang teaches if a user requests assistance, displaying questions in an order dictated by a decision tree defined in advance by an IT professional (column 3, lines 3-6), and traversing said decision tree(i.e., help tree, column 3, line 4) based upon answers provided by the user via said computer input devices until one or more recommendations for service actions have been encountered (wherein the questions are predefined, column 3, lines 6-9); and gathering all recommended service actions (suggestions) (column 3, lines 4-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, having the teachings of Miller and Chiang before him/her, to have modified the system of Miller with the teachings of Chiang, wherein the system of Miller would have incorporated the teachings of Chiang

in order to allow a user to acquire assistance manually by the user when help is desired as suggested by Chiang (column 2, line 66 to column 3, line 1).

With regard to claim 2, Miller teaches validating each answer provided by a user using constraints and/or validation formulas (fig.5, item 507; see section [0053], lines 2-14 for the different types of constraints and/or validation formulas on parameters; see also section [0033], lines 2-9, lines 16-19, and lines 22-23), and rejecting the answer and providing the user with a chance to provide the answer again if the constraints are violated or the results of evaluating said validation formula indicates the answer is invalid (fig. 5, item 508; in section [0073], lines 1-4, Miller teaches the user is given a second change to provide valid answers or cancel his/her service order).

With regard to claim 3, Miller validating the answers given against constraints and/or the results of evaluating validation formulas stored in attributes of a data field in a data structure pertaining to the answer (fig.5, item 507; see section [0053], lines 2-14 for the different types of constraints and/or validation formulas on parameters; see also section [0033], lines 2-9, lines 16-19, and lines 22-23).

With regard to claim 4, Miller teaches validating the answers given against constraints and/or the results of evaluating validation formulas stored in a service advisor which is providing assistance to said user (fig.5, item 507; see section [0053], lines 2-14 for the different types of constraints and/or validation formulas on parameters; see also section [0033], lines 2-9, lines 16-19, and lines 22-23), said constraints and/or validation formulas having been defined in advance by an IT professional when said service advisor was written (section [0038], lines 12-15). Although Miller does not

explicitly disclose a service advisor, Chiang discloses a service advisor as discussed above in the analysis of claim 1. The rationale for obviousness in combining the teachings of Miller and Chiang are discussed in the analysis of claim 1, and therefore claim 8 is rejected on that basis.

With regard to claim 5, Miller teaches automatically filling in fields in the data structures of one or more service action recommended by traversing a decision tree (conditional prompting, section [0098] , line 32) based upon answers supplied by said user (section[0046], lines 4-7, lines 9-13, and 13-17; and section [0098], lines 32-35).

With regard to claim 6, Miller teaches 6 displaying a dialog box for each unpopulated field of one or more data structures defining said one or more recommended or user selected service actions (fig. 4, items 404-432 and items 438-456), and supplying a suggested answer as a default based upon configuration attribute data of each said field defined by an IT professional when said service action was defined (i.e., Miller teaches drop-down boxes that contain suggested answers or input into data fields of a data structure (order details), see fig. 4; Miller teaches each field is defined by an IT professional, section [0038], lines 12-15).

With regard to claim 7, Miller teaches displaying an IT services catalog which contains all the IT services available to order (wherein the service catalog of Miller is directed to medical services, i.e., services per se, fig. 6, item 602 and section [0085]); determining if a user who wishes to order an IT service knows the appropriate service action to select to create an instance of the desired IT service (section [0076], lines 8-13 and section [0086], lines 1-3); Miller teaches validating responses as discussed above

in the rejection of claim 1. Miller teaches using said computer to automatically fill in all fields of one or more data structures as discussed in the rejection of claim 5 above. Miller teaches if said user does not request assistance, soliciting said user to fill in all unpopulated fields of a data structure (soliciting the user to fill in unpopulated fields shown in fig. 4) defining one or more service actions which are either selected by said user or which have been recommended by processing said decision tree and validating all user data input (Miller teaches selecting and/or creating new services in fig. 6, item 603; Miller teaches validating the user input in fig. 5, item 507; see also section [0053], lines 2-14 for the different types of constraints and/or validation formulas on parameters) and storing said data in the appropriate fields of said one or more data structures (fig. 5, items 507-510). Miller does not explicitly disclose to picking a service advisor launching a service advisor program in accordance with the user's selection, said service advisor implementing a decision tree which has IT services as its "leaves"; looking up and displaying on said computer a first dialog box or other means of soliciting information from said user about the desired IT service by asking one or more questions; repeating the process of displaying questions and receiving responses and validating said responses and vectoring processing to the next question(s) based upon the response(s) to the previous question(s) until one or more recommendations for IT service actions are encountered in said decision tree; gathering all recommendations of any service action(s) encountered in traversing said decision tree in response to answers entered by said user; nor defining one or more service actions recommended by said service advisor using information entered by said user in response to questions

posed while traversing said decision tree. However, Chiang teaches if the user does not know the appropriate service action to select or simply chooses to pick a service advisor (column 2, lines 64-66) launching a service advisor program in accordance with the user's selection (column 3, line 66 to column 4, line 1), said service advisor implementing a decision tree (i.e., help tree, column 3, line 4) which has IT services as its "leaves" (i.e., the leaves are the assistance provided by the help module of Chiang, column 2, line 65); looking up and displaying on said computer a first dialog box or other means of soliciting information from said user about the desired IT service by asking one or more questions (column 3, lines 4-6); repeating the process of displaying questions and receiving responses and validating said responses and vectoring processing to the next question(s) based upon the response(s) to the previous question(s) until one or more recommendations for IT service actions are encountered in said decision tree (column 3, lines 6-10); gathering all recommendations of any service action(s) encountered in traversing said decision tree in response to answers entered by said user (column 3, lines 4-10); defining one or more service actions recommended by said service advisor (suggestion) using information entered by said user in response to questions posed while traversing said decision tree (column 3, lines 6 – 9).Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, having the teachings of Miller and Chiang before him/her, as discussed above in the analysis of claim 1.

With regard to claim 8, Miller teaches automatically filling in any unpopulated relationship fields with pointers to the appropriate service action and/or IT resource

based upon answers previously entered in response to questions (section[0046], lines 4-7, lines 9-13, and 13-17; and section [0098], lines 32-35), if said user selected a service action, or filling in said unpopulated relationship field with data supplied by said user if said user did not select a service advisor (soliciting the user to fill in unpopulated fields as shown in fig. 4). Chiang teaches the service advisor as discussed above in the analysis of claim 7. The rationale for obviousness in combining the teachings of Miller and Chiang are discussed in the analysis of claim 7, and therefore claim 8 is rejected on that basis.

With regard to claim 9, Miller teaches validation comprising the steps of validating user input based upon constraints and/or validation formulas stored in attributes of fields in a data structure defining a service action in which the data being validated is to be stored (fig.5, item 507; see section [0053], lines 2-14 for the different types of constraints and/or validation formulas on parameters; see also section [0033], lines 2-9, lines 16-19, and lines 22-23).

With regard to claim 10, Miller teaches validation of user input based upon constraints and/or validation formulas stored (as discussed above in the analysis of claim 9) by an IT professional who defines said service advisor (section [0038], lines 12-15). Although Miller does not explicitly disclose a service advisor, Chiang discloses a service advisor as discussed above in the analysis of claim 7. Under the combination of Chiang and Miller, as discussed in the analysis of claim 7, it would have been obvious to on one of ordinary skill in the art at the time the invention was made, having the

teachings of Miller and Chiang before him or her, to have the service advisor predefined by an IT professional as suggested by Miller (section [0038], lines 12-15).

With regard to claim 11, Miller teaches conditional prompting of questions (section [0098], lines 32-35) and icons which can be selected or fields which can be filled by the user to enter commands (section [0099], lines 9-11). Chiang teaches wherein the steps of posing questions to said user are implemented by displaying dialog boxes which pose questions and provide icons which can be selected or fields which can be filled in by the user to reply to said questions (column 3, lines 4-6 and lines 6-9). The rationale for obviousness in combining the teachings of Miller and Chiang are discussed in the analysis of claim 7, and therefore claim 11 is rejected on that basis.

The limitations of claim 12 are rejected in the analysis of claim 1, and thus claim 12 is rejected on that basis.

The limitations of claim 13 are rejected in the analysis of claim 7, and thus claim 13 is rejected n that basis.

The limitations of claim 14 are rejected in the analysis of claim 1, and thus claim 14 is rejected on that basis.

The limitations of claim 15 are rejected in the analysis of claim 3, and thus claim 15 is rejected on that basis.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892 attached hereto).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan E. Corrales whose telephone number is 571-270-1283. The examiner can normally be reached on Monday - Thursday 6:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jonathan E Corrales
Examiner
Art Unit 2169

JEC
February 26, 2007

CHRISTIAN CHACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100